

III. REMARKS

Status of the Claims

Claims 1, 7, and 12 are amended. Claims 1-12 are presented for further consideration.

The Office Action and Responsive Remarks

Claims 1,7, and 12 are amended for clarification. No new matter is presented. The amendments to the claims are not intended to be limiting, are not made for reasons related to patentability, and should not be interpreted to raise issues of estoppel.

Applicant has considered the Examiner's comments set forth in the Office Action mailed May 2, 2007 and responds in detail below. Reconsideration of the application is respectfully requested in view of the amendments and the following remarks.

Claims 1-3, 5-9, and 11-12 stand rejected under 35USC103(a) based on the combined teaching of the reference Horton, et al, U.S. Patent No. 5,241,587 in view of the cited reference Olafsson, et al, U.S. Patent No. 6,912,276. This rejection is traversed on the following grounds:

The combined teaching of Horton and Olafsson does not render claims 1-3, 5-9, and 11-12 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) *In re Vaeck*, 947 F.2d 488, 20 USPQ2d

1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

In particular the combined teaching fails to disclose or suggest the claimed features of independent claim 1 as indicated below:

"activate and store a first packet data protocol context between the packet switched radio network and the mobile termination part for reception and transmission of packet-switched data;

activate a second packet data protocol context between the packet radio network and the mobile termination part to establish a dial-up connection of the terminal equipment part by a link between the terminal equipment part and the mobile terminal part or the terminal equipment part and the packet radio network,

release the active first packet data protocol context in response to said second packet data protocol context being activated, in order to minimize processor and memory loading and avoid expense,

release the dial-up connection;

release said second packet data protocol context in response to the dial-up connection being released, and

activate a third packet data protocol context, using said stored first context, in response to said second context being released."

Equivalent language is contained in independent claims 7 and 12.

The cited reference Horton describes a system of telephone switching involving relays and switches, the mechanical nature of the system of Horton is clear from the excerpt at column 5, lines 1-6 cited by the Examiner, when extended to include lines 7-15, i. e., double-pole, double-throw relays K1 and K2. There is no mention of packet data protocols (PDP), nor is there any reference to activating packet data protocol contexts. There is no provision to activate and store a first data protocol context because none are used. The functioning of the system of Horton is similar to the previously cited reference Brachman in that a call is placed on hold. This is not the same as releasing a connection. A held

call maintains a connection at some level and the connected link is not useable. The held connection in Horton survives, while the connection in the claims of this application do not. There is nothing in the reference Horton that would encourage a person skilled in the art to apply its teaching in a packet data switching system. The use of this mechanical system would not render a modern digital system more efficient, contrary to the Examiner's assertion.

The Examiner acknowledges that Horton fails to disclose a system in which, the activated first packet data protocol context is released in response to said second packet data protocol context being activated, in order to minimize processor and memory loading and avoid expense and further in which, when the dial-up connection is released, the second packet data protocol context is released and a third packet data protocol context is activated, using the stored first context, in response to said second context being released. In order to remedy this deficiency the Examiner creates a combined teaching by incorporating the disclosure of Olafsson. Applicant submits that the Examiner's reliance on Olafsson is not supported by the reference. Olafsson in the abstract states:

"The holding modem maintains the session by fooling the higher protocol layers, making them believe that the modem is not on hold. Three-way calling services are also used to free up the shared line for outgoing calls while maintaining the session with holding modems."
(see also column 2 ,lines 28-43)

Again the system of Olafsson fails to release the connection, but maintains it on hold, contrary to the system claimed in the this application. Clearly the circuit switched system of Olafsson does not release a packet data protocol context, as indicated by the examiner. The underlying technology of the combined teaching, i.e. circuit switched, is different than that of the subject application, namely, packet switched. The Examiner has selected bits and pieces of a different system and applied them directly, when the similarity can, at best, be only symbolic. The combined teaching therefore, fails to disclose or suggest the elements of the independent claims as indicated above.

The combined teaching of Horton and Olafsson is further traversed because there is no motivation in such diverse disclosures to obtain Applicant's invention. In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, the combined teaching fails to disclose or suggest each feature of Applicants' invention as claimed.

Neither reference provides the requisite suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the teaching of Horton and Olafsson. The Examiner's statement that the combined teaching would "improve efficiencies for telecommunication network" is not supported in anyway in the cited reference. As stated above the mechanical system of Horton, has nothing to recommend itself for combination with the later system of Olafsson.

The references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the references as proposed for purposes of 35 U.S.C. §103(a). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) with respect to the subject of independent claims 1,7, and 12.

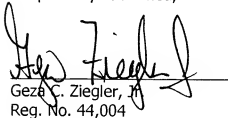
Claims 4 and 10 stand rejected based on the combined teaching of Horton and Olaffson and further in view of the cited reference Forslow, U.S. Publication No. 2003/0039237. This rejection is traversed on the same grounds as above because the disclosure of Forslow fails to remedy the deficiencies of the combined teaching of Horton and Olaffson indicated above.

These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims. None of the cited references remedy the deficiencies of the primary reference Horton.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler, Jr.
Reg. No. 44,004

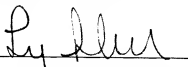
9 July 2007
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

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